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FROM: Phillip M. Pippenger
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TO: MAIL STOP Amendment
UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

FACSIMILE NUMBER: (571) 273-8300

IN RE APPLN. OF: Garrett W. Gould
APPLICATION NO. 10/762,424
FILED: January 22, 2004
GROUP ART UNIT: 2645
EXAMINER: IWUCHUKWU, EMEKA DERRICK
DOCKET NO.: 252828 (Client Reference No. GP-302931)

ATTACHED PLEASE FIND THE FOLLOWING DOCUMENTS:

- Appellant's Appeal Brief Transmittal (4 pages)
- Appellant's Appeal Brief (11 pages)

A confirmation copy of the transmitted document will:

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 10/762,424

Applicant: Garrett W. Gould

Filed: 01/22/2004

TC/AU: 2645

Examiner: IWUCHUKWU, EMEKA DERRICK

Docket No.: 252828 (Client Reference No. GP-302931)

Customer No.: 23460

**TRANSMITTAL OF
APPELLANTS' APPEAL BRIEF**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 41.37, appellants hereby submit Appellants' Brief on Appeal.

The items checked below are appropriate:

1. Status of Appellants

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

2. Fee for Filing Brief on Appeal

Pursuant to 37 CFR 41.20(2), the fee for filing the Brief on Appeal is for: ☒ other than a small entity or ☐ a small entity.

3. Oral Hearing**Brief Fee Due \$500.00**

- ☐ Appellants request an oral hearing in accordance with 37 CFR 41.47.
A separate paper requesting oral hearing is attached.

4. Extension of Time

- ☒ Appellants petition for a three-month extension of time under 37 CFR 1.136, the fee for which is \$1,020.00.
☐ Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that

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Appeal Brief Transmittal

appellants have inadvertently overlooked the need for a petition and fee for extension of time.

Extension fee due with this request: \$1,020.00

5. **Total Fee Due**

The total fee due is:

Brief on Appeal Fee	\$500.00
Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$1,020.00

Total Fee Due: \$1,5020.00

6. **Fee Payment**

- ☐ Attached is a check in the sum of \$
- ☒ Charge Account No. 12-1216 the sum of \$1,5020.00. A duplicate of this transmittal is attached.

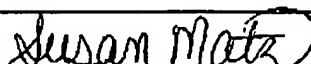
7. **Fee Deficiency.**

- ☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate copy of this transmittal is attached.

Respectfully submitted,

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Date: August 1, 2006

MAILING/TRANSMISSION CERTIFICATE UNDER 37 CFR 1.8 OR 1.10			
I hereby certify that this document and all accompanying documents are, on the date indicated below, being <input type="checkbox"/> deposited with the U.S. Postal Service using "Express Mail" service in an envelope addressed in the same manner indicated on this document with Express Mail Label Number <input type="checkbox"/> deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed in the same manner indicated on this document, or <input checked="" type="checkbox"/> facsimile transmitted to the U.S. Patent and Trademark Office at fax number: (571) 273-8300.			
Name (Print/Type)	Susan Matz		
Signature		Date	August 1, 2006

Appeal Brief Transmittal (Revised 2005 12 05)

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NO. 2738 P. 6

AUG 01 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 10/762,424

Applicant: Garrett W. Gould

Filed: 01/22/2004

TC/AU: 2645

Examiner: IWUCHUKWU, EMEKA DERRICK

Docket No.: 252828 (Client Reference No. GP-302931)

Customer No.: 23460

APPELLANT'S APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the final rejection dated January 3, 2006, Appellant now submits his Brief.

Real Party in Interest

The patent application that is the subject of this appeal is assigned to General Motors Corporation.

Related Appeals and Interferences

We are not aware of any appeals or interferences that are related to this appeal.

Status of Claims

Claims 1-6 are currently pending and stand rejected. Of these, claims 1 and 6 are independent. A copy of the claims is attached at the *Claims Appendix*. The rejection of each of pending claims 1-6 is appealed hereby.

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Status of Amendments

No amendments were submitted after the final rejection in this case, and thus there are no outstanding amendments.

Summary of Claimed Subject Matter

With respect to claim 1, the claimed subject matter pertains to a method for provisioning a telematics unit. (See specification at page 2, lines 2-3.) The first step of the method is the initiation of a wireless over-the-air service provisioning session between the telematics unit and a wireless network carrier. (*Id.* at page 4 lines 28-30.) During this step, data is downloaded from the wireless network carrier to the telematics unit (*Id.* at page 5 lines 3-4) after which point the session is terminated (*Id.* at page 5 lines 4-6).

After completion of the provisioning session between the telematics unit and the wireless network carrier, the next step of the method is the automatic initiation of a call from the telematics unit to a telematics service provider. (*Id.* at page 5 lines 10-11.) During this session, at least a portion of the data previously downloaded from the wireless network carrier to the telematics unit is uploaded to the telematics service provider. (*Id.* at page 6 lines 21-23.) An example of such transferred information includes a MIN (Mobile Identification Number).

At this point, the information can now be stored and used by the telematics service provider to make available telematics services through the telematics unit. To this end, claim 2, which depends from claim 1, recites the additional limitations of (1) updating a telematics service provider database with the data uploaded from the telematics unit; and (2) utilizing the updated database to provide telematics services through the telematics unit. (*Id.* at page 6, lines 23-26.)

It is possible that a service provisioning session with the wireless network carrier will be unsuccessful, in which case the telematics unit will not have received sufficient information from the wireless network carrier. Thus, claim 3, which depends from claim 1, further recites the steps of determining *whether* the provisioning session with the wireless network carrier was successful (*Id.* at page 5, lines 12-13) and *initiating* a telematics service provider over-the-air service provisioning session, wherein the data is downloaded to the telematics unit during this session. (*Id.* at lines 25-31). As recited in claim 4, the telematics

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service provider over the air provisioning service session is initiated in an embodiment of the invention by a vehicle ignition cycle. (*Id.* at lines 12-19). In particular, as recited in claim 5, the telematics service provider over the air service provisioning session can be initiated based on a number of ignition cycles counted within a certain period of time. (*Id.*, lines 20-24). This can prevent the telematics service provider from receiving frequent repeat calls.

The invention of independent claim 6 relates to a system for provisioning a telematics unit. The telematics unit automatically initiates a call to a telematics service provider notifying the telematics service provider of a successful provisioning session with a wireless network carrier. (*Id.*, lines 10-11). During this call, at least some provisioning data received from the wireless carrier during the prior call is transferred from the telematics unit to the telematics service provider. (*Id.*, page 6, lines 1-4). For example, a new MIN may be uploaded to the telematics service provider. (*Id.*)

Grounds of Rejection to be reviewed on Appeal

By way of the Office action mailed January 3, 2006, claims 1-5 were finally rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Pat. Publ. 2005/0075892 to Watkins (hereinafter "Watkins I"). Claim 6 was finally rejected under §102(e) as allegedly anticipated by Watkins I as well as U.S. Pat. Publ. 2004/0259524 to Watkins (hereinafter "Watkins II"). Each of these rejections is appealed.

Argument

As noted above, claims 1-5 were rejected under §102(e) as being anticipated by Watkins I and claim 6 was rejected as anticipated by Watkins I and Watkins II.

The Rejection of Claim 1 (and Claims 2-5)

With respect to claim 1, this claim recites that a telematics unit is provisioned by initiating a wireless over the air service provisioning session between the telematics unit and a wireless network carrier, wherein data is downloaded from the wireless network carrier to the telematics unit during the over the air service provisioning session, and upon completion of the over the air service provisioning session between the telematics unit and the wireless network carrier, automatically initiating a call from the telematics unit to a telematics service

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provider, wherein at least of portion of the data downloaded from the wireless network carrier to the telematics unit is uploaded to the telematics service provider.

Thus, there are three components: (1) a wireless network carrier, (2) a telematics unit, and (3) a telematics service provider. Without going into the details again (please see the summary above) a call between the first two entities provides information to the telematics unit. This information is then conveyed to the telematics service provider by a call between the last two entities.

Watkins I, on the other hand, simply teaches operating a telematics unit in a logistical support mode and then in a customer service mode and does not teach this claim combination. In fact, Watkins I only mentions "provisioning" twice, paragraphs 2 and 35. In paragraph 2, Watkins states:

... In a known example, telematics units are provisioned and activated at a point of sale when a subscriber purchases a telematics equipped vehicle....

In paragraph 35, Watkins I states:

...Now in the second mode, the telematics unit behaves in a subscriber support context and is ready to be provisioned for a specific subscriber. Alternatively the telematics unit 102 may be configured to disable logistic support mode and enable subscriber support by activating a subscriber account associated with the vehicle...

In neither section does Watkins I teach initiating a wireless over the air service provisioning session wherein data is downloaded from the wireless network carrier to the telematics unit during the over the air service provisioning session, and then automatically initiating a call from the telematics unit to a telematics service provider, wherein at least of portion of the data downloaded from the wireless network carrier to the telematics unit is then uploaded to the telematics service provider. This deficiency is not cured anywhere else in Watkins, and thus Watkins I cannot anticipate the claimed invention.

In the Office Action, the Examiner points to Watkins I, paragraphs 14, 15 and 39, as teaching the first step of claim 1. Since none of these paragraphs relate to a session between a telematics unit and a wireless network carrier or provisioning the telematics, they cannot teach the first step.

Next, the Examiner points to Watkins I, paragraphs 40 and 42, as teaching the second step. Paragraphs 40 and 42 refer to sending logistical support and warranty data to a service

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provider and do not teach or suggest sending data received from a wireless network carrier during provisioning to a telematics service provider. Thus, paragraphs 40 and 42 cannot teach the second step of claim 1.

In responding to the Applicant's remarks, the Office asserted that Watkins I indeed teaches all limitations of claim 1 as follows:

Watkins teaches warranty data (paragraph 17) is downloaded from the wireless network carrier (the virtual programming station, paragraphs 11-17) which wirelessly connects to the telematics unit (paragraph 15) and also establishes a connection with the TSP via a wireless network (paragraph 16), to the telematics unit (paragraphs 11-17) during the over the air provisioning session (paragraphs 11-17)... [and] at least a portion of the data (warranty data, paragraphs 15-17, 39, 40) downloaded from the wireless network carrier (paragraphs 11-17) to the telematics unit is uploaded to the TSP (paragraphs 39, 40).

However, this reasoning fails for a number of reasons.

First, it assumes incorrectly that the virtual programming station is a wireless network carrier, which it clearly is not. Watkins I characterizes the virtual programming station as simply being an entity that obtains telematics application programs and downloads them to the telematics unit. In fact, the virtual programming station is not even *necessarily* wirelessly connected (as one would have expected of a wireless network carrier). See para. 15 (connection may be physical or wireless).

Moreover, the downloaded data (application programs) are not later uploaded to the TSP. In fact, these downloaded programs came to the virtual programming station from the TSP in the first place! (para. 16; TSP provides virtual programming station with access to the telematics applications programs).

Although the action references the "warranty data" as being downloaded from the virtual programming station and then provided to the telematics unit, Watkins I clearly indicates that the warranty data comes from the vehicle itself, not the virtual programming station. See para. 17-18 (Warranty data includes vehicle diagnostic codes, battery voltage, security system status, signals from vehicle input and output devices; warranty data is collected via the vehicle bus.) The warranty data and the manner of collection clearly show that the data originates at the vehicle itself, not the virtual programming station. The cited additional paragraphs 39 and 40 simply repeat this information.

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Because Watkins I does not teach the combined steps of claim 1, it cannot anticipate claim 1 or any of the other claims 2-5.

The Rejection of Claim 6

With respect to claim 6, the final action alleges that Watkins I teaches each element of the recited system for essentially the same reasons applied to claims 1-5. However, even without considering the other limitations of claim 6, Watkins I does not teach notifying a telematics service provider of a successful provisioning session with a wireless network carrier and transferring provisioning data (received from the wireless carrier) to the telematics service provider. First, as noted above, the virtual programming station is not a wireless network carrier. Secondly, also as noted above, the cited warranty information originates at the vehicle, not at the virtual programming station.

With respect to claim 6, the final action additionally alleges that Watkins II teaches each element of the claim. In particular, the action states that Watkins II teaches a system for provisioning a telematics unit, wherein the telematics unit automatically initiates a call to a telematics service provider (paragraph 47) notifying the telematics service provider of a successful provisioning session with a wireless network carrier (paragraphs 42-47) and wherein at least some provisioning data (authentication data, paragraphs 46,47) from the wireless carrier is transferred from the telematics unit to the telematics service provider (paragraphs 42-47).

However, Watkins II is similarly inapplicable to claim 6. First, the cited paragraphs 42-47 do not relate to “notifying the telematics service provider of a successful provisioning session with a wireless network carrier.” These paragraphs describe communication between the telematics unit in the vehicle and the telematics service provider. The cited “authentication information” comes not from a third party wireless network carrier, but rather the telematics service provider itself;

The service provider then provides a configuration data communication to the MVCU 200. The communication ... may additionally include telematics device configuration and subscription service data such as, for example ... telematics device authentication data

See para. 46. After configuration and triggering, the authentication data is transmitted back to the service provider.

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When the MVCU 200 initiates an activation event based on the occurrence of an activation event trigger parameter, an inbound communication is initiated to register an authentication key. An inbound call is generated outside a call center and transmitted into the call center.

See para. 47. Note that the terms "call center" and "service provider" may be used synonymously. See para. 34. The remainder of Watkins II does not cure the noted deficiencies. Thus, the system of Watkins II does not teach the recited system of claim 6 for at least these reasons.

Conclusion

Because the asserted rejections of claims 1-6 under §102 rely on references that simply do not teach each element of any pending claim as required, Applicant therefore respectfully requests that the Examiner be instructed to withdraw the pending rejections of claims 1-6.

Respectfully submitted,



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Date: August 1, 2006

Appeal Brief (Revised 12/05/05)

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Claims Appendix

1. (Previously Presented) A method for provisioning a telematics unit comprising the steps of:

initiating a wireless over-the-air service provisioning session between the telematics unit and a wireless network carrier, wherein data is downloaded from the wireless network carrier to the telematics unit during the over the air service provisioning session; and

upon completion of the over-the-air service provisioning session between the telematics unit and the wireless network carrier, automatically initiating a call from the telematics unit to a telematics service provider, wherein at least a portion of the data downloaded from the wireless network carrier to the telematics unit is uploaded to the telematics service provider.

2. (Original) The method of claim 1, also comprising the steps of:

updating a database at the telematics service provider with the data uploaded from the telematics unit; and

utilizing the updated database to provide telematics services through the telematics unit.

3. (Original) The method of claim 1 further comprising the steps of:

determining whether the over-the-air service provisioning session with the wireless network carrier was successful;

responsive to the determining step, if the over-the-air service provisioning session with the carrier was not successful, initiating a telematics service provider over-the-air service provisioning session, wherein the data is downloaded to the telematics unit during the telematics service provider over-the-air service provisioning session.

4. (Original) The method of claim 3, wherein the telematics service provider over the air provisioning service session is initiated by a vehicle ignition cycle.

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5. (Original) The method of claim 3, wherein the telematics service provider over the air service provisioning session is initiated based on a number of ignition cycles counted within a predetermined period of time.

6. (Previously Presented) A system for provisioning a telematics unit, wherein the telematics unit automatically initiates a call to a telematics service provider notifying the telematics service provider of a successful provisioning session with a wireless network carrier and wherein at least some provisioning data from the wireless carrier is transferred from the telematics unit to the telematics service provider.

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Evidence Appendix

NONE

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Related Proceedings Appendix

NONE